

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Dean L. Engelhardt et al.

Serial No. 08/486,069

Group Art Unit: 1631

Filed: June 7, 1995

Examiner: Ardin H. Marschel, Ph.D.

Title: NUCLEIC ACID SEQUENCING PROCESSES USING NON-RADIOACTIVE DETECTABLE MODIFIED NUCLEOTIDES OR NUCLEOTIDE ANALOGS, AND OTHER PROCESSES FOR NUCLEIC ACID DETECTION AND CHROMOSOMAL CHARACTERIZATION USING SUCH NON-RADIOACTIVE MODIFIED NUCLEOTIDES OR NUCLEOTIDE ANALOGS (As Previously Amended)

**TRANSMITTAL
SIXTH INFORMATION DISCLOSURE STATEMENT**

Director of Patents and Trademarks
Washington, D.C. 20231

Sir:

Transmitted herewith is a Sixth Information Disclosure Statement which is being filed in accordance with 37 C.F.R. §§ 1.56 and 1.97-1.98. The items listed on Form PTO-1449, a copy of which is enclosed, may be deemed to be pertinent to the above-identified application and are made of record to assist the Patent and Trademark Office in its examination of this application. The Examiner is respectfully requested to fully consider the items and to independently ascertain their teaching.

1. ☒ For each of the following items listed on the enclosed copy of Form PTO-1449 that is not in the English language, an English language translation of that item or a portion thereof or a concise explanation of the relevance of that item is enclosed.
2. ☐ For each of the following items listed on the enclosed copy of form PTO-1449 that is not in the English language, a concise explanation of the relevance of that item is incorporated in the specification of the above-identified application.
3. ☐ Any copy of the items on the enclosed copy of Form PTO-1449 that is not enclosed with this Information Disclosure Statement was previously cited by or submitted to the Patent and Trademark Office in the prior ☐ Divisional or ☐ Continuation-In-Part application under 37 C.F.R. §1.60, U.S. Serial No. _____, filed _____.

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Dean L. Engelhardt et al.

Serial No.: 08/486,069

Filed: June 7, 1995

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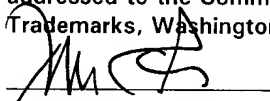
-- September 12, 2002

EXPRESS MAIL CERTIFICATE

"Express Mail" Label No. EV115518576US

Deposit Date September 12, 2002

I hereby certify that this paper and the attachments herein are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner of Patents and Trademarks, Washington DC 20231.



Ronald C. Fedus
Reg. No. 32,567

SEPT 12 2002

Date

Dean L. Engelhardt et al.

Serial No.: 08/486,069

Filed: June 7, 1995

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-- September 12, 2002

4. ☐ No fee is due under 37 C.F.R. §1.17(p) for this Information Disclosure Statement since it is being filed in compliance with:

☐ 37 C.F.R. §1.97(b)(1), within three months of the filing date of the above-identified application.

☐ 37 C.F.R. §1.97(b)(2), within three months of the date of entry into the national stage as set forth in 1.491 in an international application.

☐ 37 C.F.R. §1.97(b)(3), before the mailing date of a first Office action on the merits.

5. ☐ No fee is due under 37 C.F.R. §1.17(p) for this Information Disclosure Statement since it is being filed in compliance with 37 C.F.R. §1.97(c), after the period specified in paragraph 4 above but before the mailing date of a final action or a Notice of Allowance (where there has been no prior final action), and is accompanied by one of the certifications pursuant to 37 C.F.R. §1.97(e) set forth in paragraph 9 below.

6. ☒ A fee is due under 37 C.F.R. §1.17(p) for this Information Disclosure Statement since it is being filed in compliance with 37 C.F.R. §1.97(c), after the period specified in paragraph 4 above but before the mailing date of a final action or a notice of allowance (where there has been no prior final action):

☐ A check in the amount of \$240.00 is enclosed in payment of the fee.

☒ Charge the fee to Deposit Account No. 05-1135, Order No. ENZ-5(D8)(C2). A DUPLICATE COPY OF THIS SHEET IS ATTACHED.

7. ☐ A fee is due under 37 C.F.R. §1.17(i)(1) for this Information Disclosure Statement since it is being filed in compliance with 37 C.F.R. §1.97(d), after the mailing date of a final action or a notice of allowance, whichever comes first, but before payment of the issue fee, and is accompanied by:

-- September 12, 2002

- a. one of the certification pursuant to 37 C.F.R. §1.97(e) set forth in paragraph 9 below; and
 - b. the attached petition requesting consideration of this Information Disclosure Statement; and
 - c. the fee due under 37 C.F.R. §1.17(i)(1) which is paid as set forth in paragraph 10 below.
8. ☐ A fee is due under 37 C.F.R. §1.17(i)(1) for this Information Disclosure Statement since it is being filed in compliance with:
- a. ☐ 37 C.F.R. §1.313(b)(3), after the issue fee has been paid and information cited in this Information Disclosure Statement may render at least one claim unpatentable and is accompanied by the attached Petition To Withdraw Application From Issue;
 - b. ☐ 37 C.F.R. §1.313(b)(5), after the issue fee has been paid and information cited in this Information Disclosure Statement is to be considered in a Continuation application upon abandonment of the instant application and is accompanied by the attached Petition To Withdraw Application From Issue.
 - c. ☐ The fee due under 37 C.F.R. §1.17(i)(1) is paid as set forth in paragraph 10 below.
9. ☐ I hereby certify that each item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement.
- ☐ I hereby certify that no item of information in the Information Disclosure Statement filed herewith was cited in a communication from a foreign patent office in a counterpart foreign application or, to my knowledge after making reasonable inquiry, was known to any individual designated in 1.56(c) more than three months prior to the filing of this Information Disclosure Statement.
10. ☐ A check in the amount of \$130.00 is enclosed in payment of the fee due under 37 C.F.R. §1.17(i)(1).

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[X] Charge the fee under 37 C.F.R. §1.17(i)(1) to Deposit Account No. 05-1135, Order No. Enz-5(D8)(C2). A DUPLICATE COPY OF THIS SHEET IS ATTACHED.

[x] The Commissioner is hereby authorized to charge any additional fees which may be required for this Information Disclosure Statement, or credit any overpayment to Deposit Account No. 05-1135. A DUPLICATE COPY OF THIS SHEET IS ATTACHED.

Respectfully submitted,

Dated: September 12, 2002

By: 
RONALD C. FEDUS
Registration No. 32,567
Attorney for Applicants

Mailing Address:

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Dean Engelhardt et al.)
Serial No.: 08/486,069)
Filed: June 7, 1995)
For: NUCLEIC ACID SEQUENCING PROCESSES)
USING NON-RADIOACTIVE DETECTABLE)
MODIFIED OR LABELED NUCLEOTIDES OR)
NUCLEOTIDE ANALOGS, AND OTHER)
PROCESSES FOR NUCLEIC ACID DETECTION)
AND CHROMOSOMAL CHARACTERIZATION)
USING SUCH NON-RADIOACTIVE DETECTABLE)
MODIFIED OR LABELED NUCLEOTIDES OR)
NUCLEOTIDE ANALOGS (As Previously Amended)

Group Art Unit: 163

Ex'r: Ardin H. Marscher, Ph.D.

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527 Madison Avenue, 9th Floor
New York, New York 10022-4303
September 12, 2002

FILED BY EXPRESS MAIL

Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

**SIXTH INFORMATION DISCLOSURE
STATEMENT UNDER 37 C.F.R. §§1.56 & 1.97-1.98**

Dear Sirs:

Pursuant to the provisions of 37 C.F.R. §§1.97-1.98, and in full compliance with their duty of disclosure under 37 C.F.R. §1.56, Applicants, through their attorney, are bringing the following seven (7) documents in the form of English translations to the attention of the U.S. Patent and Trademark Office and the Examiner handling their above-identified application:

Enz-5(D8)(C2)

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Serial No.: 08/486,069

Filed : June 7, 1995

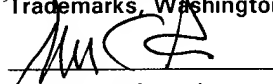
Page 2 [(Information Disclosure Statement Under 37 C.F.R. §§1.56 & 1.97-1.98)
- September 12, 2002]

EXPRESS MAIL CERTIFICATE

"Express Mail" Label No. EV115518576US _____

Deposit Date September 12, 2001 _____

I hereby certify that this paper and the attachments
herein are being deposited with the United States Postal
Service "Express Mail Post Office to Addressee" service
under 37 CFR 1.10 on the date indicated above and is
addressed to the Commissioner of Patents and
Trademarks, Washington DC 20231.



Ronald C. Fedus

Reg. No. 32,567

SEPT 12 2002

Date

Dean L. Engelhardt et al.

Serial No.: 08/486,069

Filed : June 7, 1995

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– September 12, 2002]

1. Japanese Patent Application No. S59-44648, Applicant: Mimata Seisakusho Co., Ltd.; Inventor: Takashi Satoh; Filed: September 7, 1982; Published: March 13, 1984 [**Exhibit 1** herewith] (formerly Exhibit 30 in September 19, 2001 Fourth Information Disclosure Statement);
2. Japanese Patent Application No. S59-93100; Applicant: Wakunaga Industries Co., Ltd.; Inventor: Ryo Fuwa; Filed: August 9, 1982; Published: May 29, 1984 [**Exhibit 2**] (formerly Exhibit 31 in September 19, 2001 4th IDS);
3. Japanese Patent Application No. S59-126252; Applicant: Fuji Photo Film Co., Ltd.; Inventor: Hisashi Shiraishi; Filed: January 8, 1983; Published: July 20, 1984 [**Exhibit 3**] (formerly Exhibit 32 in September 19, 2001 4th IDS);
4. Japanese Patent Application No. S60-161559; Applicant: Hitachi Ltd.; Inventor: Hideki Kamihara et al.; Filed: February 1, 1984; Published: August 23, 1985 [**Exhibit 4**] (formerly Exhibit 33 in September 19, 2001 4th IDS);
5. Japanese Patent Application No. S60-242368; Applicant: Hitachi Ltd.; Inventor: Yoshinori Harada et al.; Filed: May 16, 1984; Published: December 2, 1985 [**Exhibit 5**] (formerly Exhibit 34 in September 19, 2001 4th IDS);
6. Japanese Patent Application No. S49-126395; Applicant: Toshio Maeda, President, Kyoto University; Inventor: Masanobu Tokushige; Filed: April 4, 1973; Published: March 12, 1974 [**Exhibit 6**] (formerly Exhibit 44 in September 19, 2001 4th IDS); and
7. Japanese Patent Application No. S58-502205; Applicant: Pasteur Institute; Inventor: Kourilsky et al.; Filed: December 29, 1982; Published: December 22, 1983 [**Exhibit 7**] (formerly Exhibit 46 in September 19, 2001 4th IDS).

Copies of the above-listed 7 documents are being submitted herewith as Exhibits 1-7. A completed Form PTO-1449 is also attached as Exhibit 8.

As indicated above, each of the above-listed 7 documents were listed and submitted in Applicants' September 19, 2001 Fourth Information Disclosure Statement. These English translations were prepared in response to the October 9, 2001 Office Action (page 3) in which the Examiner indicated that "several citations [on PTO Form 1449] are lined through thereon because they are in Japanese which

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cannot be considered by the examiner due to this different language and no English translation has been supplied."

By this voluntary citation of art, Applicants and their attorney are requesting that these 7 documents (Exhibits 1-7) be made of record if appropriate in the present application.

The above listing is not a representation that these documents constitute a complete or exhaustive listing, nor that the above listing necessarily includes the closest or most relevant references, nor are these documents necessarily a complete listing of all references known to Applicants or their attorneys. It is simply a voluntary citation of references made in good faith, which is not intended to serve in any way as a substitute for the Examiner's own searches.

In view of the general and specific features described and claimed in the present application, Applicants respectfully submit that the present invention is neither suggested nor disclosed by the documents listed above and, thus, patentably distinct thereover. Furthermore, Applicants do not believe, and do not submit, by the citation of these documents, that these documents, either by themselves or in combination with other documents, render the invention *prima facie* obvious under any of the duty of disclosure rules.

Applicants respectfully request that the Examiner make the above-submitted documents (Exhibits 1-7) of record in the instant application. Applicants further request that the Examiner consider these documents as any of them may relate, however remotely, to the present application.

This IDS is being filed in accordance with 37 C.F.R. §1.97(c), that is, after the mailing date of a first action on the merits, but before the mailing date of either a Final Action or a Notice of Allowance. The Patent and Trademark Office is hereby authorized to charge the \$180.00 fee set forth in §1.17(p) and any other

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– September 12, 2002]

fees in connection with this IDS to Deposit Account No. 05-1135, or to credit any
overpayment thereto.

Respectfully submitted,



Ronald C. Fedus

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Attorney for Applicants

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